

Pursuant to 37 C.F.R. §§1.136(a) and 1.17(a), it is respectfully requested that the period for reply be extended one month, i.e., to up to and including September 26, 2007. A check in the amount of \$120.00 is enclosed. Additionally, the Commissioner is authorized to charge any additional fee, or to credit any overpayment in fees, to Deposit Account 50-0320.

### **REMARKS**

The July 27, 2007 Office Action required restriction from among the following species:

- I. First Embodiment (Page 22, lines 8-27);
- II. Second Embodiment (Page 28, lines 17-27 and Page 29, lines 1-14);
- III. Third Embodiment (Page 35, lines 16-27);
- IV. Fourth Embodiment (Page 40, lines 9-27);
- V. Fifth Embodiment (Page 46, lines 1-7);
- VI. Sixth Embodiment (Page 50, lines 8-27); and
- VII. Seventh Embodiment (Page 52, lines 1-18).

Applicants hereby elect, **with traverse**, for further prosecution of this application, the species corresponding to the First Embodiment and identify claims 1 to 4, 11 and 12 as being readable on the provisionally elected species.

The First, Second, Third, Fourth, Fifth, Sixth and Seventh Embodiments are all related to each other in that **all** the claims are drawn to a semiconductor device having a multilayer structure. If the restriction requirement is nonetheless maintained, Applicants reserve the right of rejoinder of the subject matter of the non-elected claims or the right to pursue canceled subject matter in a continuation and/or divisional application.

It is respectfully submitted that examination of all of the claims pending in this application is in the spirit of the right of rejoinder such that the restriction requirement should be reconsidered, and reformulated or withdrawn entirely.

It would seem that to require the filing of six separate divisional applications directed to the claims readable on the Second, Third, Fourth, Fifth, Sixth & Seventh Embodiments will result in the very same search being repeated, but at a later date. It is submitted that these duplicate searches would be quite inefficient to the operation of the Patent and Trademark Office and result in a significant loss of applicant's patent term. Furthermore, it is likely that the same Examiner would be in charge of the divisional applications; but since the divisional applications will be examined at a much later date, the Examiner will have to conduct duplicate, redundant searches at the time he examines the divisional applications. Alternatively, if a different Examiner were assigned to these divisional applications, a significant loss of PTO efficiency would be incurred as a result of the examination of the divisional applications.

Thus, the only logical outcome of the present restriction requirement would be to delay the examination of the claims readable on the Second, Third, Fourth, Fifth, Sixth & Seventh Embodiments, resulting in inefficiencies and unnecessary expenditures by Applicants and the PTO, and since a single search can be performed for all species of claims without any significant burden on the Office, it is respectfully requested that this restriction requirement be withdrawn.

Specifically, the Examiner's attention is drawn to independent claim 9, which includes all limitations of independent claims 1, 5, 7 and 11 together. Therefore, a search on the Examiner's part for independent claim 9, which is narrower than the other independent claims, would cover all the claims in the present application. That is, claim 9 links the groups of claims

1, 5, 7 and 11, and provides a basis for search and examination of all embodiments without any undue burden. Indeed, the text at page 22, lines 8-27, page 28, line 17 to page 29, lines 1-14, page 35, lines 16-27, page 40, lines 9-27, page 46, lines 1-9, page 50, line 8 to page 51, line 5, and page 52, lines 1-18, *inter alia*, shows that there is sufficient common features among the embodiments that they form a unitary inventive concept, and may be searched and examined together without any serious or undue burden on the Examiner. Applicants provide this merely as an example and do not intend to limit the scope of these claims in any manner.

In this regard the Examiner is respectfully invited to consider the extreme prejudice to Applicants by the present restriction requirement, including: the necessity of having to pay additional filing fees to the PTO and others for prosecuting six additional applications; the loss of patent term for the claims readable on the Second, Third, Fourth, Fifth, Sixth & Seventh Embodiments if Applicant must now file six additional and separate applications at this time directed thereto due to prosecution of such applications beginning far later than prosecution to date in the present application; and to the post GATT 20 year patent term calculating from the earliest U.S. filing date.

Additionally, the Examiner is respectfully invited to review the text of MPEP §803, which in part states (with emphasis) that:

If the search and examination of an entire application can be **made without serious burden, the examiner must examine it on the merits**, even though it includes claims to distinct or independent inventions.

The results of the present restriction requirement are inefficiencies and unnecessary expenditures by both Applicants and the PTO, and extreme prejudice to the Applicants. Therefore, the restriction has not been shown to be proper, especially since the requisite showing of serious burden has not been made in the Office Action and that the claims

readable on the First, Second, Third, Fourth, Fifth, Sixth & Seventh Embodiments are all related to a semiconductor device having a multilayer structure.

In addition, as to traverse this Restriction Requirement, the Examiner is asked to review MPEP § 704.01, which is reproduced below for your convenience.

#### PREVIOUS EXAMINER'S SEARCH

When an examiner is assigned to act on an application which has received one or more actions by some other examiner, full faith and credit should be given to the search and action of the previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general the second examiner should not take an entirely new approach to the application or attempt to reorient the point of view of the previous examiner, or make a new search in the mere hope of finding something.

In this case, a restriction requirement was issued by the former Examiner in an Office Action mailed on January 12, 2005, A first Office Action on the merits was mailed on May 26, 2005, a second Office Action was mailed on November 29, 2005, a third Office Action was mailed on May 17, 2006, and a final Office action was mailed on November 2, 2006. This application has already been searched and examined by the previous Examiner. As such, under MPEP § 704.01, the current Examiner should not have to make a new search in the absence of clear error, or “take an entirely new approach,” or “attempt to reorient the point of view of the previous examiner.” While applicants have amended the claims when they filed the RCE, all of the claims are still directed to the same subject matter, therefore a new search is not warranted..

A new course of action this late in prosecution results in inefficiency and unnecessary expenditures by both the Applicants and the PTO, and extreme prejudice to Applicants (particularly in view of GATT, as any divisional applications filed will have a

shortened patent term). Restriction has not been shown to be proper, especially since the requisite showing of serious burden has not been made.

Hence, it is evident that there is unity of invention in the pending claims, and in view of the foregoing, reconsideration and withdrawal of the restriction requirement and favorable reconsideration of all of the claims on the merits are respectfully requested.

Moreover, if the restriction requirement is nonetheless maintained, Applicants reserve the right of rejoinder or the right to pursue canceled subject matter in a continuation and/or a divisional application as mandated by the MPEP.

### **CONCLUSION**


In view of the foregoing, reconsideration and withdrawal of the Restriction Requirement and favorable reconsideration of the claims readable on the First, Second, Third, Fourth, Fifth, Sixth and Seventh Embodiments on the merits are respectfully requested.

Any additional fee occasioned by this paper, or any overpayment in those fees, may be charged or credited to Deposit Account No. 50-0320.

Respectfully submitted,

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